

REMARKS

The Official Action mailed August 8, 2007, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on April 20, 2004; September 3, 2004; September 14, 2004; August 11, 2005; April 21, 2006; and November 9, 2006.

A further Information Disclosure Statement is submitted herewith and consideration of this Information Disclosure Statement is respectfully requested.

Claims 24-38 were pending in the present application prior to the above amendment. Claims 24, 25, 27 and 30 have been amended to correct minor informalities, and new dependent claims 39-43 have been added to recite additional protection to which the Applicant is entitled. The Applicant notes with appreciation the allowance of claims 30 and 37 (pages 4-5, Paper No. 20070803). For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 24, 26 and 33 as obvious based on the combination of U.S. Publication No. 2005/0245007 to Azami and U.S. Patent No. 6,700,096 to Yamazaki. The Official Action rejects claims 26-29, 31-36 and 38 as obvious based on the combination of U.S. Patent No. 6,506,635 to Yamazaki and Yamazaki '096. The Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or

references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Independent claims 24-29 of the present application recite that an energy beam is blocked in a position in which a scanning direction of the energy beam changes or means for blocking the energy beam. The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims. The Official Action concedes that Azami or Yamazaki '635 "fails to disclose blocking the beam in a direction in which the scanning direction changes" (pages 2 and 3, Paper No. 20070803). The Official Action asserts that "Yamazaki '096 discloses "blocking the beam in a direction in which the scanning direction changes ... using a shutter to block the energy beam [0128]" (Id.). The Applicant respectfully disagrees and traverses the assertions in the Official Action.

The Applicant respectfully submits that Yamazaki '096, in fact, does not teach or suggest that an energy beam is blocked in a position in which a scanning direction of the energy beam changes. Yamazaki '096 may teach that "laser lights are blocked by a shutter ... thereby irradiating the laser lights only onto each predetermined portion" (column 14, lines 61-65; and Figure 14). However, the position blocked by the shutter is not a position in which a scanning direction of the energy beam changes but a predetermined portion. Upon reviewing Figure 14 of Yamazaki, the Applicant respectfully submits that a predetermined portion does not correspond to a position in

which a scanning direction of an energy beam changes but includes a same scanning direction.

Therefore, the Applicant respectfully submits that Azami or Yamazaki '635 and Yamazaki '096, either alone or in combination, do not teach or suggest all the features of the independent claims of the present application.

Since Azami or Yamazaki '635 and Yamazaki '096 do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

The Official Action rejects claims 24-29 under the doctrine of obviousness-type double patenting over claims 1-27 of U.S. Patent No. 7,220,627 to Yamazaki. The Applicant respectfully submits that the independent claims of the subject application are patentably distinct from the claims of the Yamazaki '627 patent.

As stated in MPEP § 804, under the heading "Obviousness-Type," in order to form an obviousness-type double patenting rejection, a claim in the present application must define an invention that is merely an obvious variation of an invention claimed in the prior art patent, and the claimed subject matter must not be patentably distinct from the subject matter claimed in a commonly owned patent. Also, the patent principally underlying the double patenting rejection is not considered prior art.

Claim 1 of Yamazaki '627 appears to claim that a scanning direction of an energy beam changes outside and between a first element-forming region and a second element-forming region. On the other hand, claims 24-29 of the present application recite that an energy beam is blocked in a position in which a scanning direction of the energy beam changes or means for blocking the energy beam. The claims of Yamazaki '627 do not teach or suggest the above-referenced features of the present independent claims.

Therefore, it is respectfully submitted that the claims of the present application are not a timewise extension of the invention as claimed in the Yamazaki '627 patent.

Reconsideration and withdrawal of the obviousness-type double patenting rejections are requested.

New dependent claims 39-43 have been added to recite additional protection to which the Applicant is entitled. The features of claims 39-43 are supported in the present specification, for example, by page 2, lines 20-22. For the reasons stated above and already of record, the Applicant respectfully submits that new claims 39-43 are in condition for allowance.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,


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